

Amendment and Response

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Serial No.: 09/520,032

Confirmation No.: 9385

Filed: 6 March 2000

For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

Remarks

The Office Action mailed 20 September 2004 has been received and reviewed. The pending claims are claims 17, 19-21, 25-28, 33-54, 94-96, and 98-111. Reconsideration and withdrawal of the rejections are respectfully requested.

Allowed Claims

Applicants thank the Examiner for notification to the effect that claim 19 has been allowed, and that claim 17 would be allowable when the Obviousness-Type Double Patenting Rejection is overcome.

Obviousness-Type Double Patenting Rejection

Claims 17, 20, 21, 25-28, 33-54, 94-96, and 98-111 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23, 24, 30-32, 89, 90, 92, 93, and 133-148 of co-pending Application No. 09/955,604. Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

The 35 U.S.C. §103 Rejection

The Examiner rejected claims 20, 21, 25-28, 33-54, 94-96, and 98-111 under 35 U.S.C. §103(a) as being unpatentable over Picper et al. (U.S. Patent No. 5, 152, 917) in view of Rochlis (U.S. Patent No. 3,312,583) and either Nelson et al. (U.S. Patent No. 5,273,558) or Calhoun (U.S. Patent No. 5,437,754). Applicants respectfully traverse this rejection.

The present application is a continuation application that, through a line of applications, is entitled to the benefit of a September 13, 1993 effective filing date. Among the references cited in support of this rejection, both Nelson et al. and Calhoun have publication dates after the effective filing date of the present application. Nelson et al. issued on December 28, 1993 (over

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three months after the effective filing date of the present application) while Calhoun issued on August 1, 1995 (almost two years after the effective filing date of the present application).

Furthermore, neither Nelson et al. nor Calhoun qualifies as prior art for an obviousness rejection under the provisions of 35 U.S.C. §102(e). Title 35 U.S.C. §103(c) provides that "subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

At the time the invention of the instant application was made, the claimed invention and the inventions of both Nelson et al. and Calhoun were owned by (or subject to an obligation of assignment to) the same entity.

Accordingly, Applicants submit that the rejections under 35 U.S.C. §103(a) are rendered moot because Nelson et al. and Calhoun are not prior art for obviousness purposes in view of 35 U.S.C. §103(c). More specifically, because Nelson et al. and Calhoun qualify as prior art only under subsection (e) of 35 U.S.C. §102, they must be excluded as prior art for obviousness purposes for the reasons set forth above.

In addition, Applicants expressly reserve the right to establish a date of invention for the claims subject to this rejection before the effective date of Pieper et al. at a later time.

For at least the above-reasons, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of claims 20, 21, 25-28, 33-54, 94-96, and 98-111 under 35 U.S.C. §103(a) in view of the cited references. Applicants respectfully request reconsideration and withdrawal of the rejection.

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It is respectfully submitted that the pending claims 17, 19-21, 25-28, 33-54, 94-96, and 98-111 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
HOOPMAN et al.

By

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20 DEC. 2004

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20th day of December, 2004, at 3:20 p.m. (Central Time).

By: Rachel Gagliardi-GabauName: Rachel Gagliardi-Gabau